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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,803	07/22/2003	Toyofumi Hayashi	393032039600	6651
7590	11/03/2006			EXAMINER LAMB, CHRISTOPHER RAY
David L. Fehrman Morrison & Foerster LLP 35th Floor 555 W. 5th Street Los Angeles, CA 90013			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/624,803	HAYASHI, TOYOFUMI
	Examiner	Art Unit
	Christopher R. Lamb	2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 August 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 10 and 17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 10 and 17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/7/06.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: translation of JP 2002-203321.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. (JP 2002-203321; disclosed in IDS; machine translation relied upon for rejection) in view of Izumi et al. (US 5,859,824).

Honda discloses:

An apparatus for recording data and a visible image (Fig. 9) on an optical disk (Fig. 1; paragraph 10) having at least a substrate surface (Fig. 1: 12), a label surface opposite to the substrate surface (Fig. 1: 18), a recording face interposed between the substrate surface and the label surface (Fig. 1: 14), and a reflection layer disposed under the recording face (Fig. 1: 16), the recording face being irradiated by a laser light through the substrate surface to record and reproduce data (paragraph 10), the apparatus comprising:

an optical pickup having an objective lens for irradiating the laser light to the optical disk through the objective lens (Fig. 9: 66);

a feed means for moving the optical pickup in a radial direction of the optical disk (paragraph 14);

a spindle motor for rotationally driving the optical disk (paragraph 13); and
a host computer for controlling the recording of the data and the visible image
(paragraph 16), wherein

the substrate surface of the optical disk faces to the optical pickup when the data
is recorded into the recording face (not specifically stated, but inherent: with the position
of the reflection layer 16 the recording face must be irradiated from the substrate side),

the label surface of the optical disk faces to the optical pickup when the visible
image is recorded into the label surface (paragraph 4), and

a distance between the optical lens and the optical disk is differentiated between
a first case of recording the data on the recording face and a second case of recording
the visible image on the label surface (this is inherent. The recording surface and the
label surface are at different depths inside the disk from their respective outer sides, as
shown in Fig. 1. Thus in order to focus on each layers, the optical lens must be moved
to a different position), and

a focus servomechanism for focusing the laser light onto the optical disk by
means of the objective lens (paragraph 14).

Honda does not disclose:

"a gain of the focus servomechanism is switched between the first case of
recording the data on the recording face and the second case of recording the visible
image on the label surface."

Izumi discloses:

a gain of a focus servomechanism must be switched between focusing on different layers with different reflective properties (column 1, line 65 to column 2, line 10). Izumi discloses that this is necessary to accurately perform servo control (column 2, lines 5-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Honda wherein a gain of a focus servomechanism is switched between the first case of recording the data on the recording face and the second case of recording the visible image on the label surface, as taught by Izumi.

(Izumi does not specifically refer to the case of recording a visible image on the label surface, but since the label layer of Honda will clearly have different reflective properties from the standard recording layer – it is behind a different thickness of substrate, and is a different kind of material – the teaching of Izumi is clearly applicable.)

The motivation would have been to accurately perform servo control.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda in view of Katsuyama et al. (US 4,723,234).

Honda discloses an apparatus for recording data and a visible image on an optical disk: most elements of this claim have been identified in Honda in the rejection of claim 10 above.

Honda does not disclose:

"wherein the host computer checks if the label surface of the optical disk is set to face the optical pickup when the optical disk is set."

Katsuyama discloses checking to see if the label surface of the optical disk is set to face the optical pickup when the optical disk is set; Katsuyama discloses that this avoids focusing malfunctions (column 1, lines 19-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Honda as taught by Katsuyama to include wherein the host computer checks if the label surface of the optical disk is set to face the optical pickup when the optical disk is set.

The motivation would be to avoid malfunctions, as taught by Katsuyama (Katsuyama is trying to avoid malfunctions while playing the disk, because it cannot be played with the label side the wrong way, but the extension to Honda is obvious: the label cannot be recorded if the label side is set the wrong way).

Response to Arguments

4. Applicant's arguments with respect to claims 10 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on August 7th, 2006 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

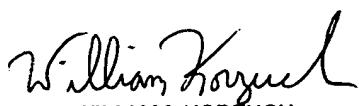
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lamb whose telephone number is (572) 272-5264. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRL 10/16/06


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